



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/521,555

01/19/2005

Pierre Doublet

052014

9342

38834 7590 06/06/2007
WESTERMAN, HATTORI, DANIELS & ADRIAN, LLP
1250 CONNECTICUT AVENUE, NW
SUITE 700
WASHINGTON, DC 20036

EXAMINER

DICUS, TAMRA

ART UNIT

PAPER NUMBER

1774

MAIL DATE

DELIVERY MODE

06/06/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/521,555	Applicant(s) DOUBLET, PIERRE	
	Examiner Tamra L. Dicus	Art Unit 1774	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) ____ is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>01-19-05</u> | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Specification

The title of the invention is not completely in the English language ("recto/verso" is Latin). A new title is required.

The following title is suggested: Double-side printed security document.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 9-10, 13-14 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The Examiner believes that dependent claims 9-10 and 13-14 do not have the proper support in the original specification as filed because the specification does not provide any teaching or discussion on algorithms or encryptions (no mathematical equations could be found) or its usage with Applicant's claimed security.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Art Unit: 1774

4. Claims 1-4, 6, 7, 10-11, 14-16, 19-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
5. Claim 1 recites the language “document that includes, as security element”, which is not clear if applicant meant “Comprises” or “used as”. Claims 10, 12, and 16 have similar issues using “includes”.
6. Claims 2, 11, 15, and 20 use “and/or” and “especially” which is ambiguous since it is not clear if one over the other options listed are preferred or both are, it is unclear whether the limitation(s) following the phrase are part of the claimed invention. See MPEP § 2173.05(d).
7. Claims 3, 6, 10, 14, and 19 recite the term “in particular” which is unclear because it is a vague term, not specifying a preference of either lines or dots (claim 3), sides (claim 6), lines or encryption (claims 10, 14, 19). Further regarding said claims, the phrase “in particular” renders the claim indefinite because it is unclear whether the limitation(s) following the phrase are part of the claimed invention. See MPEP § 2173.05(d).
8. The terms “large” and “very” in claim 4 is a relative term, which renders the claim indefinite. Said terms are not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-11, 13-15, and 17-20 are rejected under 35 U.S.C. 102(a) and (b) as being anticipated by Zeiter et al. (CA 2335239).

Zeiter teaches a security (page 6, lines 30-31) (counterfeit-proof, equivalent to against copying) having on both sides of a transparent material 10, superimposed, overlapping, and identical images 12 and 14, of patterns of lines (inherently comprised of dots, because individual dots in a line produce lines), in a spatial relationship (because said lines are the same spaced on both sides, they are in series and complementary), changing also in viewing angle, using a mathematical equation (page 6, lines 5-32, and page 7, 10-32, FIG. 1 and associated text) resulting in a three dimensional moiré effect, observed in reflected light. The resolution of the image is very fine. The language of Zeiter thus meets the limitations of instant Claims 1-11, 13-15, and 17-20. Further to the lines generated by algorithms and encryptions are process limitations in product claims. Product-by-process claims are not limited to the manipulations of the recited steps, only the structure implied by the steps. Patentability of an article depends on the article itself and not the method used to produce it (see MPEP 2113). Furthermore, the invention defined by a product-by-process invention is a product NOT a process. *In re*

Art Unit: 1774

Bridgeford, 357 F. 2d 679. It is the patentability of the product claimed and NOT of the recited process steps which must be established. *In re Brown*, 459 F. 2d 531. Both Applicant's and prior art reference's product are the same.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Andric et al. in view of Zeiter.

Andric teaches a security paper with a watermark (element) and superimposed, overlapping, and identical indicia on both sides that is observed in reflected light and viewed in transmitted light (18, 20, 22, Fig. 1 and associated text, 12:1-35) on a paper support (10, Fig. 1), where the images are numerals, words, or symbols in any number combination (9:1-10, embraces dots, alternating, varying). Regions 40, 42, 44, 46, 48 (Fig. 1) are transparent (thus including a region of reduced opacity as per instant claim 12. Also Fig. 2 teaches a similar paper, including any pigments to increase opacity. The images are printed using fluorescent or magnetic inks (13:1-15). The language of Andric thus addresses the limitations of instant Claims 1-20.

Further to the lines generated by algorithms and encryptions are process limitations in product claims. Product-by-process claims are not limited to the manipulations of the recited steps, only the structure implied by the steps. Patentability of an article depends on the article itself and not the method used to produce it (see MPEP 2113). Furthermore, the invention defined by a product-by-process invention is a product NOT a process. *In re Bridgeford*, 357 F. 2d 679. It is the patentability of the product claimed and NOT of the recited process steps which must be established. *In re Brown*, 459 F. 2d 531. Both Applicant's and prior art reference's product are the same.

Andric does not teach the indicia are three-dimensional (instant claim 1).

Zeiter teaches a security (page 6, lines 30-31) (counterfeit-proof, equivalent to against copying) having on both sides of a transparent material 10, superimposed, overlapping, and identical images 12 and 14, of patterns of lines (inherently comprised of dots, because individual dots in a line produce lines), in a spatial relationship (because said lines are the same spaced on both sides, they are in series and complementary), changing also in viewing angle, using a mathematical equation (page 6, lines 5-32, and page 7, 10-32, FIG. 1 and associated text) resulting in a three dimensional moiré effect, observed in reflected light.

It would have been obvious to one having ordinary skill in the art to have modified the teaching of Andric to include or use three dimensional indicia because Zeiter teaches a similar security produces an optical effect as an aid to prevent counterfeiting as cited above.

12. Claims 12 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zeiter et al. (CA 2335239) in view of Doublet et al.

Art Unit: 1774

13. Zeiter essentially teaches the claimed invention above.
14. Zeiter does not expressly teach a paper support, while using cardboard-type supports (per instant claims 12 and 16).
15. Doublet teaches a paper having print on it having transparent areas to make a sheet very difficult to reproduce with a copier (5:50-68).
16. It would have been obvious to one having ordinary skill in the art to have modified the Zeiter reference to include or use a reduced opacity paper in regions as claimed because Doublet teaches a paper having print on it having transparent areas to make a sheet very difficult to reproduce with a copier (5:50-68).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tamra L. Dicus whose telephone number is 571-272-1519. The examiner can normally be reached on Monday-Friday, 7:00-4:30 p.m., alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye can be reached on 571-272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR

Art Unit: 1774

system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Tamra L. Dicus
Examiner
Art Unit 1774

May 15, 2007



RENA DYE
SUPERVISORY PATENT EXAMINER

AU 1774